

Attorney Docket No.:  
Inventor:  
Serial No.:  
Filing Date:  
Page 4

BI-0004US.P1  
Simons and Gao  
09/426,011  
October 25, 1999

#### REMARKS

Claims 11 and 15-16 are pending in the instant application. Claims 11 and 15-16 have been rejected. Claim 11 has been amended. No new matter has been added by this amendment. Reconsideration is respectfully requested in light of the following remarks.

#### **I. Rejection of Claims Under 35 U.S.C. §112**

Claims 11 and 15-16 have been rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. It is suggested that while the specification teaches two species of the claimed genus of PR-39 derived oligopeptides, i.e., SEQ ID NO:4 and SEQ ID NO:5, the claim encompasses numerous species that are not further described. It is suggested that "comprising" leaves the claim open for the inclusion of unspecified ingredients even in major amounts and the specification does not clearly allow persons of ordinary skill in the art to recognize that Applicants have invented what is claimed. Applicants respectfully disagree with this rejection.

The specification clearly describes at least two species of peptides of 8 to 11 amino acid residues in length with the N-terminal amino acid sequence of Arg-Arg-Arg-Pro-Arg-Pro-Pro-Tyr. Accordingly, in an earnest effort to impart the structure of the disclosed species into the claimed genus of peptides, Applicants have amended claim 11 to indicate that the claimed PR-39 derived oligopeptide family consists of a peptide of 8 to 11 amino acid residues in length with the N-terminal amino acid sequence of Arg-Arg-Arg-Pro-Arg-Pro-Pro-Tyr (SEQ ID NO:5). Support for this

Attorney Docket No.: **BI-0004US.P1**  
Inventor: **Simons and Gao**  
Serial No.: **09/426,011**  
Filing Date: **October 25, 1999**  
Page 5

amendment is found at page 26 of the instant specification. In light of this amendment, Applicants believe that a clear and concise description of the structure of the disclosed and claimed family of PR-39 derived oligopeptides has been provided and the written description requirement has been met. It is therefore respectfully requested that this rejection under 35 U.S.C. 112 be reconsidered and withdrawn.

## **II. Rejection of Claims Under 35 U.S.C. §103**

Claims 11, 15 and 16 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Ross et al. (U.S. Patent No. 6,133,233). It is suggested that Ross et al. discloses SEQ ID NO:4, a peptide which includes the instant invention's SEQ ID NO:4 and SEQ ID NO:5 and therefore from the teachings of this reference, the skilled artisan would have had a reasonable expectation of success in producing the claimed invention. Applicants respectfully traverse this rejection in light of the claims as presently amended.

While Ross et al. disclose a 14 amino acid peptide with the N-terminal amino acid sequence of Arg-Arg-Arg-Pro-Arg-Pro-Pro-Tyr, Ross et al. do not enable the use of the 14 amino acid peptide to interact selectively in-situ with proteasomes or alter markedly the proteolytic degradation of at least one identifiable peptide mediated by the interacting proteasomes. As such, there would be no reasonable expectation of success in truncating the 14 amino acid peptide of Ross et al. to an 8 to 11 amino acid residue peptide with the N-terminal amino acid sequence of Arg-Arg-Arg-Pro-Arg-Pro-Pro-Tyr as presently claimed to achieve selective inhibition of proteasome-mediated degradation of

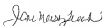
Attorney Docket No.: **BI-0004US.P1**  
Inventor: **Simons and Gao**  
Serial No.: **09/426,011**  
Filing Date: **October 25, 1999**  
Page 6

peptides in-situ. Thus, this reference cannot be held to make the present invention obvious. It is therefore respectfully requested that this rejection be reconsidered and withdrawn.

### **III. Conclusion**

The Applicants believe that the foregoing comprises a full and complete response to the Office Action of record. Accordingly, favorable reconsideration and subsequent allowance of the pending claims is earnestly solicited.

Respectfully submitted,

  
Jane Massey Licata  
Registration No. 32,257

Date: **December 21, 2006**

Licata & Tyrrell P.C.  
66 E. Main Street  
Marlton, New Jersey 08053

(856) 810-1515